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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,459	10/29/2003	Taro Suzuki	YTO-004	4579

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EXAMINER	
SCHLIENTZ, LEAH H	
ART UNIT	PAPER NUMBER
1618	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/695,459	SUZUKI ET AL.	
	Examiner	Art Unit	
	Leah Schlientz	1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 January 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *36 and 37* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *36-37* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Acknowledgement of Receipt

Applicant's Response, filed 1/2/2009, in reply to the Office Action mailed 8/1/2008, is acknowledged and has been entered. Claims 36 and 37 have been amended. Claims 36 and 37 are pending and are examined herein on the merits for patentability.

Response to Arguments

Applicant's arguments with respect to the rejection of claims 36 and 37 under 35 USC 102(b) as being anticipated by Hikada *et al.* (JP 59-100715) have been fully considered but they are moot in view of new grounds of rejection presented herein, as necessitated by changes in scope of the amended claims.

Applicant's arguments with respect to the rejection of claims 36 and 37 under 35 USC 102(a) as being anticipated by Fujimori *et al.* (JP 2003081842), have been fully considered. The rejection has been WITHDRAWN in view of the Declaration of Taro Suzuki and Mitsuhito Teramoto.

Applicant's arguments with respect to the rejection of claims 36 and 37 under 35 USC 102(b) as being anticipated by Tougi *et al.* (JP 2000281511), have been fully

considered but they are moot in view of new grounds of rejection presented herein, as necessitated by changes in scope of the amended claims.

Applicant's arguments with respect to the rejection of claims 36 and 37 under 35 USC 102(b) as being anticipated by Hertlein *et al.* (WO 02/056687, whereby US 2002/0169147 is relied upon as equivalent), have been fully considered but they are moot in view of new grounds of rejection presented herein, as necessitated by changes in scope of the amended claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 36 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Hikada *et al.* (JP 59-100715).

Hikada teaches synthetic fibers containing 0.1 to 30% poly(p-vinylphenol). The fibers have lasting antimicrobial action. The fibers are useful for socks, underwear and carpet (abstract and page 67).

Accordingly, Hikada practices the claimed active method steps (i.e. supplying at least one compound selected from an aromatic hydroxyl compound having in a linear polymer a substituent represented by formula 1 (Applicant's elected species poly-4-

vinyl phenol) in an object, i.e. carpet, where dust mites are known to occur), and thus must inherently accomplish the same method.

Regarding the limitation of "denaturing or adsorbing the acarian allergens by contacting the allergens with a denaturing effective amount or an adsorbing effective amount," it is noted that such a phrase simply expresses the intended result of the active method step (i.e. providing the compound in an object and contacting the object with acarian allergen). Since Hikada practices the claimed method step by incorporating the compound into carpet fiber (i.e. an environment where acarian species are known to reside, as evidenced by the specification of the instant application which teaches incorporation of the same compound into carpet fiber for denaturing acarian allergen), then Hikada would inherently inhibit acarian allergen, whether or not such a result was specifically stated by Hikada. "Products of identical chemical composition cannot have mutually exclusive properties." A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure or composition as that which is claimed, the properties applicant discloses and/or claims are necessarily present. See *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). The "discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." See *Atlas Power Co. v. Ireco Inc.*, 51 USPQ 2d 1943, 1947 (Fed. Cir. 1999). Therefore, merely claiming a new use, new function, or new property, which is

inherently present in the prior art does not make the claim patentable. See *In re Best,* 195 USPQ 430, 433 (CCPA 1977), and MPEP § 2112.

Regarding the limitation wherein the compound is provided in a denaturing effective amount or an adsorption effective amount, it is noted that the specification of the instant application describes that an effective amount of aromatic hydroxy compound is 1 mg to 10 g per 1 m^2 of carpet (paragraph 0047), or that a sheet, fiber or fabric may be incorporated with 0.1 to 100% by weight (paragraph 0091-0097). Since Hikada teaches 0.1 to 30% poly(p-vinylphenol), such an amount is the same as that which applicant defines to be an effective amount, thus Hikada meets the claims.

The following references drawn to a non-elected species were found during the search for the elected compound. It should not be interpreted that a comprehensive search was performed for all non-elected species.

Claims 36 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Tougi *et al.* (JP 2000281511).

Tougi discloses an acaricide spray solution comprising 0.1 to 70% polyoxyethylene lauryl sulfate. The acaricide is preferably used as a spray (see abstract). Regarding the instantly claimed limitation “where the reactivity of the acarian allergens to specific antibodies is to be inhibited by denaturing or adsorbing the acarian allergens,” it is noted that Tougi does not specifically recite that acaricidal activity is achieved via denaturation or adsorption, however, such activity would inherently occur upon application of the spray disclosed by Tougi. See MPEP 2112. "[T]he discovery

of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).

Regarding the limitation wherein the compound is provided in a denaturing effective amount or an adsorption effective amount, it is noted that the specification of the instant application describes that an effective amount of aromatic polyoxyethylene lauryl ether sulfate is 1 mg to 10 g per 1 m^2 of carpet (paragraph 0058), or a 3% solution (example 31). Since Tougi teaches 0.1 to 70% polyoxyethylene alkyl ether sulfate, such an amount is the same as that which applicant defines to be an effective amount, thus Tougi meets the claims.

Claims 36 and 37 are rejected under U.S.C. 102(b) as being anticipated by Hertlein *et al.* (WO 02/056687, whereby US 2002/0169147 is relied upon as equivalent).

Hertlein discloses compositions for controlling pests. The compositions are employed for the control of arthropods, especially of mites and cockroaches. There is a need for measures to control arthropods and allergens. Allergens are generally controlled by denaturing them. The compositions include combinations of components

selected from at least two, preferably from three, of groups a, b and c, wherein group b is a surfactant such as sodium lauryl sulphate (abstract; paragraphs 0005 - 0009). From 0.01 to 10 parts by weight of component b is disclosed at paragraph 0036. Since Hertlein discloses denaturing allergens, such an amount must be an effective amount for denaturation.

Conclusion

No claims are allowed at this time.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leah Schlientz whose telephone number is 571-272-9928. The examiner can normally be reached on Monday - Friday 8 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on 571-272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael G. Hartley/
Supervisory Patent Examiner, Art Unit 1618

LHS